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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,891	01/05/2001	Steven D. Ims	RSW920000077US	4751
58505	7590	06/26/2007	EXAMINER	
STEVENS & SHOWALTER, L.L.P. BOX IBM 7019 CORPORATE WAY DAYTON, OH 45459-4238			RIES, LAURIE ANNE	
		ART UNIT	PAPER NUMBER	
		2176		
		MAIL DATE	DELIVERY MODE	
		06/26/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 09/754,891

Filing Date: January 05, 2001

Appellant(s): IMS ET AL.

JUN 26 2007

Technology Center 2100

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Robert L. Showalter  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 27 April 2007 appealing from the Office action mailed 27 July 2006.

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**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

"e" speak Tutorial, Version: Beta 20.2" Hewlett-Packard Company, December 1999.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claims Rejections – 35 U.S.C. 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by "e" speak Tutorial, Version: Beta 20.2" Hewlett-Packard Company, December 1999 [hereinafter "E-Speak"].

Regarding **independent claim 1, as amended**, E-Speak teaches:

*A computer program product for automated e-business services, the computer program product embodied on one or more computer-readable media of a first computing system and comprising:*

*computer-readable program code configured for reading a specification of an e-business service; and*

*computer-readable program code configured for processing the specification to carry out the e-business service, further comprising:*

*computer-readable program code configured for receiving at least one input document for the e-business service; and*

*computer-readable program code configured for performing at least one of: transforming the input documents into other documents, according to transformation information that may be provided in the specification, and operating upon the input documents or the other documents to create one or more new documents, according to operating actions that may be provided in the specification.*

(Initially, it is noted that claims 1-7 were amended to specify, in several contexts, a "computer-readable program code configured . . .," where the limitation "configured" was

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amended into the claims. The term "configured" is not named or discussed in the specification. It was known to one of ordinary skill in the art at the time of the invention to be defined as follows: "The arrangement of a computer system or component as defined by the number, nature, and interconnections of its constituent parts." See, "IEEE 100, The Authoritative Dictionary of IEEE Standards Terms," Seventh Edition, IEEE Press, 2000, definition of "configure." Upon review of the claims, as amended, and the disclosure, the Examiner believes that the applicants intended the term "configured" to be read as limited to the embodiments disclosed as the specific "configuration" or "arrangement" of the computer system. The Examiner's interpretation of this limitation is further based on the fact that the prior limitation of the broader "means for . . ." was amended out of the claims. Claims 1-7 will be so read for the remainder of this Office Action.

It is further noted that the term "specification" is not defined in the specification. E-Speak defines "specification" as follows: "The events-service specification defines two interfaces. Namely, ListenerIntf: It defines the format of event notifications. DistributorIntf: It defines the format of publish and subscribe requests." See, E-Speak, page 35-36. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of "specification" will be used in this Office Action.

It is further noted that the term "service" is not specifically defined in the specification. E-Speak defines "service" as follows: "A **service** is essentially a program written in a programming language. A service adheres to its **contract** and its

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**vocabulary.** **Service Contracts:** A contract defines the set of interfaces that a service implements. Contracts can be discovered and used just like any other service. **Service Vocabularies:** A vocabulary consists of a set of attributes and associated properties. Vocabularies can be discovered and used just like any other service.” See, E-Speak, page 5 [emphasis and bold in the original]. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of “service” will be used in this Office Action.

E-Speak contains code for reading and processing a specification of an e-business service. See, E-Speak, pages 35-40.

E-Speak will receive an XML document and transform the input into a DOM document. See, E-Speak, pages 76-77.

See also, E-Speak, page 72, center, teaching the receipt of input from a client to instruct E-Speak to look for “a specific kind of PC – made by HP and price is lower than \$1500.” The search request is an input document.)

Regarding **dependent claim 2, as amended**, E-Speak teaches:

*The computer program product according to claim 1, further comprising computer-readable program code configured for forwarding the other documents or the new documents to a computing system other than the first computing system.*

(See, E-Speak, page 81, teaching that the E-Speak service provider's advertisements are automatically transferred to all the advertising services belonging to the same group.)

Regarding **dependent claim 3**, E-Speak teaches:

*The computer program product according to claim 1, wherein the specification and the input documents are encoded in a structured markup language.*

(See, E-Speak, pages 76-77, teaching that the input documents are encoded in a structured markup language of XML.)

Regarding **dependent claim 4**, E-Speak teaches:

*The computer program product according to claim 1, wherein the other documents and the new documents are encoded in a structured markup language.*

(See, E-Speak, pages 76-77, teaching that the input documents are encoded in a structured markup language of XML.)

Regarding **dependent claim 5, as amended**, E-Speak teaches:

*The computer program product according to claim 3, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.*

(See, E-Speak, pages 71-72 and 76-77, teaching that the input documents are encoded in a structured markup language of XML and a DOM.)

Regarding **dependent claim 6, as amended**, E-Speak teaches:

*The computer program product according to claim 1, wherein the computer-readable program code configured for operating upon the input documents or the other documents further comprises:*

*computer-readable program code configured for invoking one or more software-implemented processes; and*  
*computer-readable program code configured for coordinating results of the invocations.*

(See, E-Speak, page 10, teaching the invocation of the start() process.)

Regarding **dependent claim 7, as amended**, E-Speak teaches:

*The computer program product according to claim 6, further comprising computer-readable program code configured for repetitively executing the computer-readable program code configured for processing, until reaching a final result of the e-business service, wherein the other documents, the new*

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*documents, or the coordinated results of the invocations now function as the input documents.*

(See, E-Speak, page 81, teaching that the E-Speak service provider's advertisements are automatically transferred repeatedly to all the advertising services belonging to the same group.)

Regarding **claims 8-14, as amended**, claims 8-14 incorporate substantially similar subject matter as claimed in claims 1-7, respectively, and are rejected along the same rationale.

Regarding **claims 15-21, as amended**, claims 15-21 incorporate substantially similar subject matter as claimed in claims 1-7, respectively, and are rejected along the same rationale.

Regarding **independent claim 22, as amended**, E-Speak teaches:

*A method of conducting business by using automated e-business services, comprising:*

*reading a specification of an e-business service; and*

*processing the specification to carry out the e-business service, further comprising:*

*receiving at least one input document for the e-business service;*

*and*

*performing at least one of: transforming the input documents into other documents, according to transformation information that may be provided in the specification, and operating upon the input documents or the other documents to create at least one new document, according to operating actions that may be provided in the specification.*

(It is noted that the term "specification" is not defined in the specification. E-Speak defines "specification" as follows: "The events-service specification defines two interfaces. Namely, ListenerIntf: It defines the format of event notifications. DistributorIntf: It defines the format of publish and subscribe requests." See, E-Speak, page 35-36. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of "specification" will be used in this Office Action.

It is further noted that the term "service" is not specifically defined in the specification. E-Speak defines "service" as follows: "A **service** is essentially a program written in a programming language. A service adheres to its **contract** and its **vocabulary**. **Service Contracts**: A contract defines the set of interfaces that a service implements. Contracts can be discovered and used just like any other service. **Service Vocabularies**: A vocabulary consists of a set of attributes and associated properties. Vocabularies can be discovered and used just like any other service." See, E-Speak, page 5 [emphasis and bold in the original]. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of "service" will be used in this Office Action.

E-Speak contains code for reading and processing a specification of an e-business service. See, E-Speak, pages 35-40.

E-Speak will receive an XML document and transform the input into a DOM document. See, E-Speak, pages 76-77.

See also, E-Speak, page 72, center, teaching the receipt of input from a client to instruct E-Speak to look for "a specific kind of PC – made by HP and price is lower than \$1500." The search request is an input document.)

Regarding **independent claim 23, as amended**, E-Speak teaches:

*A method of defining e-business process and data interactions, further comprising:*

*defining data inputs to be used by an e-business service;*

*defining interactions to be carried out when operating the e-business service;*

*specifying details of the data inputs in a structured markup language syntax;*

*specifying details of the interactions in the structured markup language syntax; and*

*creating at least one e-business service definition document separate from at least one input document containing the data inputs wherein the specified details of the data inputs and the specified details of the interactions are recorded in the at least one e-business service definition document.*

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(It is noted that the term "specification" is not defined in the specification. E-Speak defines "specification" as follows: "The events-service specification defines two interfaces. Namely, ListenerIntf: It defines the format of event notifications. DistributorIntf: It defines the format of publish and subscribe requests." See, E-Speak, page 35-36. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of "specification" will be used in this Office Action.

It is further noted that the term "service" is not specifically defined in the specification. E-Speak defines "service" as follows: "A **service** is essentially a program written in a programming language. A service adheres to its **contract** and its **vocabulary**. **Service Contracts**: A contract defines the set of interfaces that a service implements. Contracts can be discovered and used just like any other service. **Service Vocabularies**: A vocabulary consists of a set of attributes and associated properties. Vocabularies can be discovered and used just like any other service." See, E-Speak, page 5 [emphasis and bold in the original]. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of "service" will be used in this Office Action.

E-Speak contains code for reading and processing a specification of an e-business service. See, E-Speak, pages 35-40.

E-Speak will receive an XML document and transform the input into a DOM document. See, E-Speak, pages 76-77.

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See, E-Speak, page 5, teaching that a contract service is used to create and use documents as contrasts.)

Regarding **dependent claim 24**, E-Speak teaches:

*The method according to claim 23, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.*

(See, E-Speak, pages 71-72 and 76-77, teaching that the input documents are encoded in a structured markup language of XML and a DOM.)

Regarding **independent claim 25, as amended**, E-Speak teaches:

*A method of defining process and data interactions for an application described by a finite state machine, comprising:*

*defining data inputs to be used by the application;*

*defining interactions to be carried out when operating the application;*

*specifying details of the data inputs in a structured markup language syntax;*

*specifying details of the interactions in the structured markup language syntax; and*

*creating at least one application definition document separate from at least one input document containing the data inputs wherein the specified details of the data inputs and the specified details of the interactions are recorded in the at least one application definition document.*

(It is noted that the term “specification” is not defined in the specification. E-Speak defines “specification” as follows: “The events-service specification defines two interfaces. Namely, ListenerIntf: It defines the format of event notifications. DistributorIntf: It defines the format of publish and subscribe requests.” See, E-Speak, page 35-36. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of “specification” will be used in this Office Action.

It is further noted that the term “service” is not specifically defined in the specification. E-Speak defines “service” as follows: “A **service** is essentially a program written in a programming language. A service adheres to its **contract** and its **vocabulary**. **Service Contracts:** A contract defines the set of interfaces that a service implements. Contracts can be discovered and used just like any other service. **Service Vocabularies:** A vocabulary consists of a set of attributes and associated properties. Vocabularies can be discovered and used just like any other service.” See, E-Speak, page 5 [emphasis and bold in the original]. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of “service” will be used in this Office Action.

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E-Speak contains code for reading and processing a specification of an e-business service. See, E-Speak, pages 35-40.

E-Speak will receive an XML document and transform the input into a DOM document. See, E-Speak, pages 76-77.

See, E-Speak, page 5, teaching that a contract service is used to create and use documents as contrasts.

See, E-Speak, pages 71-72 and 76-77, teaching that the input documents are encoded in a structured markup language of XML and a DOM.)

Regarding **dependent claim 26**, E-Speak teaches:

*The method according to claim 25, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.*

(See, E-Speak, pages 71-72 and 76-77, teaching that the input documents are encoded in a structured markup language of XML and a DOM.)

Regarding **independent claim 27, as amended**, E-Speak teaches:

*A method for automating data and process interactions between a first application and one or more other applications, comprising steps of: providing at least one application definition document encoded in a structured markup language, wherein the application definition documents specify the interactions and at least one data input to be used in the interactions,*

*and wherein details of the specified interactions and data inputs are specified in the structured markup language; and*  
*processing the application definition documents to carry out the data and process interactions in response to receiving at least one separate input document containing the at least one data input.*

(See, E-Speak, pages 75-77, teaching the providing and processing of documents in XML with specified interactions and data inputs in XML.)

Regarding **dependent claim 28, as amended**, E-Speak teaches:

*The method according to claim 27, wherein processing the application definition documents further comprises:*  
*receiving at least one input document to be used by the interactions; and performing at least one of: transforming the input documents into other documents, according to transformation information that may be provided in the application definition documents, and operating upon the input documents or the other documents to create at least one or more new document, according to operating actions that may be provided in the application definition documents.*

(See, E-Speak, pages 76-77, teaching that E-Speak will receive an XML document and transform the input into a DOM document.)

Regarding **dependent claim 30**, E-Speak teaches:

*The method according to claim 27, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.*

(See, E-Speak, pages 76-77, teaching that E-Speak will receive an XML document and transform the input into a DOM document.)

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

#### **(10) Response to Argument**

Appellant argues that eSpeak fails to disclose a specification or any other application definition document encoded in a structured markup language. The Office respectfully disagrees. As recited in Appellant's claim 5, XML, or eXtensible Markup Language, is a structured markup language. ESpeak discloses in Appendix A, Pages 71-76, that an XML document is received prior to starting the automated e-business service (See eSpeak, Page 71, Step 3, lines 6-7). Specifically, eSpeak discloses acquiring, or getting the XML document using a getXMLDocument utility procedure (see eSpeak, Page 76, line 51). The XML document is passed into the postRequest

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procedure as a String variable (See eSpeak, line 57) and is subsequently converted into a DOM document (See eSpeak, Page 76, line 63). Therefore, the Office maintains that eSpeak discloses a specification, or application definition document, encoded in a structured markup language, such as XML.

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., specifying in structured markup language syntax details of interactions to be carried out when operating an e-business service or an application described by a finite state machine) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Laurie Ries



Conferees:

William Bashore



WILLIAM BASHORE  
PRIMARY EXAMINER



Stephen Hong

STEPHEN HONG  
SUPERVISORY PATENT EXAMINER